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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,560	11/30/2001	Mark Philip Gibbons	6337.1028	3825
7590	08/17/2004			EXAMINER
Geoffrey R. Myers, Esquire Hall, Priddy, Myers & Vande Sande Ste. 200 10220 River Road Potomac, MD 20854			FOWLKES, ANDRE R	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/996,560	GIBBONS, MARK PHILIP 	
	Examiner	Art Unit	
	Andre R. Fowlkes	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 January 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-11 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/28/02.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .
5) Notice of Informal Patent Application (PTO-152)
6) Other: ____ .

DETAILED ACTION

1. Claims 1-11 are pending.

Drawings

2. The drawings are objected to because the text in all of the drawings is undecipherable. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The use of the trademarks Microsoft ® .Net and Java ™ has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3, 4 and 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3, 4 and 9-11 contain the trademark/trade names Microsoft ® .Net and/or Java ™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any

particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe programming languages/frameworks and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 9-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention, as disclosed in claim 9, is directed to non-statutory subject matter. While the claim is in the technological arts, it is not limited to "a practical application of an abstract idea which produced a useful, concrete, and tangible result." State Street Bank & Trust v. Signature Financial Group, Inc., 149 F. 3d 1368, 1375 n. 9 (Fed. Cir. 1998).

Specifically, claim 9 is directed to a computer program, designed to allow bi-directional communication between objects, comprising tools for specifying

assemblies and generating proxies. This computer program can be interpreted to be a software program, per se. Thus, Applicants fail to disclose that this computer program is tangibly embodied and executed by a piece of hardware and that its functions have practical applications which produce useful, concrete, and tangible results under the State Street Formation.

Claims 10-11, are also rejected under 35 U.S.C. 101 as being a computer program that can be interpreted as a software program that is not tangibly embodied and executed by a piece of hardware.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas et al., (Thomas), U.S. Patent Publication No. 2002/0143641.

As per claim 1, Thomas discloses **a method for allowing objects in a first programming language to communicate with objects in a second programming language** (p. col. :, ""), **comprising:**

- **receiving metadata information from a server running said second programming language on a client running said first programming language** (p. 1 col. R:32, "(a server) transmits metadata to the client"),
- **generating proxies for said first programming language from said metadata information, using a development tool for said first programming language, wherein said proxies are generated by a one-to-one mapping of classes from said second programming language to said first programming language** (p. 1 col. R:32-35, "transmits metadata to the client enabling the client to locate the ... proxy. (Proxies are available for) Java (and) common language runtime (i.e. a first and second programming language technologies")>,
- **implementing said proxies on said client, wherein said method is provided solely in said first programming language and said client does not require any components from said second programming language** (p. 1 col. R:41-44, "the client downloads the requested communication proxy and dynamically interacts, at runtime, with an Internet service using the requested communication proxy, the communication proxy being local to the client").

As per claim 2, the rejection of claim 1 is incorporated and further, Thomas discloses **using said proxies to enable bi-directional communication**

between said client and said server (Fig. 1, and associated text, (e.g. p. 1 col. R:54-61)).

As per claim 3, the rejection of claim 1 is incorporated and further, Thomas discloses that **said first programming language is Java and said second programming language is CLR** (p. 1 col. R:33-35, “transmits metadata to the client enabling the client to locate the ... proxy. (Proxies are available for Java (and) common language runtime (i.e. a first and second programming language technologies)”).

As per claim 5, the rejection of claim 1 is incorporated and further, Thomas discloses that **said client and said server communicate using SOAP formatted messages** (p. 1 col. R:36-39, “The application-level communication protocols include ... SOAP”).

As per claim 6, the rejection of claim 1 is incorporated and further, Thomas discloses that **said client and said server communicate using binary formatted messages** (p. 2 col. L:4-6, “the metadata data (communicated) can be ... binary (formatted messages)”).

As per claim 7, the rejection of claim 1 is incorporated and further, Thomas discloses **passing said proxies to a runtime tool using said first programming language** (p. 1 col. L:8-12, “this invention relates to ...

dynamically interacting , at runtime, with an Internet service using ... (a proxy", and figure 1, and associated text, (e.g. p. 1 col. R:54-61), shows a proxy being passed at runtime).

As per claim 8, the rejection of claim 7 is incorporated and further, Thomas discloses that **said runtime tool is capable of operating independently of said development tool** (figure 1, and associated text, (e.g. p. 1 col. R:54-61) shows the runtime operation, independently of the development operation).

As per claim 9, Thomas discloses a **computer program, comprising:**

- a tool for specifying .Net assemblies and generating corresponding Java proxies** (p. 1 col. R:33-35, "(Proxies are generated for communication between) Java (and) common language runtime (i.e. a first and second programming language technologies")>,
- a tool for specifying Java classes and generating corresponding .Net proxies** (p. 1 col. R:33-35, "(Proxies are generated for communication between) Java (and) common language runtime (i.e. a first and second programming language technologies")>,
- wherein said computer program is designed to allow bi-directional communication between objects in Java and objects in .Net framework using .Net Remoting** (Fig. 1, and associated text, (e.g. p. 1 col. R:54-61), and p. 1 col. R:33-35, "(Proxies are run for communicating between) Java (and)

common language runtime (i.e. a first and second programming language technologies").

As per claim 10, the rejection of claim 9 is incorporated and further, Thomas discloses **a Java-based runtime tool for handling said Java proxies and said .Net proxies** (p. 1 col. R:33-35, "(Proxies are run for communicating between) Java (and) common language runtime (i.e. a first and second programming language technologies").

As per claim 11, the rejection of claim 10 is incorporated and further, Thomas discloses that **said Java-based runtime tool is capable of operating independently of said Java-based tools for generating Java and .Net proxies** (figure 1, and associated text, (e.g. p. 1 col. R:54-61) shows the runtime operation, independently of the development operation and p. 1 col. R:33-35, "(Proxies are run for) Java (and) common language runtime (i.e. a first and second programming language technologies").

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al., (Thomas), U.S. Patent Publication No. 2002/0143641 in view of Zhang, U.S. Patent Publication No. 2003/0101235.

As per claim 4, the rejection of claim 1 is incorporated and further, Thomas discloses that **said second programming language is Java** (p. 1 col. R:33-35, "transmits metadata to the client enabling the client to locate the ... proxy. (Proxies are available for) Java (and) common language runtime (i.e. a first and second programming language technologies)").

Thomas doesn't explicitly disclose that **said first programming language is .Net Remoting**. However, Zhang, in an analogous environment, discloses that **said first programming language is .Net Remoting** (p. 7 col. R:17-20, "(the) messages can sit on a number of communication ... (protocols, including Microsoft .NET Remoting").

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Zhang into the system of Thomas to use .NET Remoting. The modification would have been obvious because one of ordinary skill in the art because one would want the flexibility and convenience of using .Net remoting to communicate across any protocol.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre R. Fowlkes whose telephone number is (703)305-8889. The examiner can normally be reached on Monday - Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703)305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ARF



TUAN DAM
SUPERVISORY PATENT EXAMINER